THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BENJAMIN JOFFE

Appeal No. 1999-1779
Application No. 08/480,561

HEARD: MAY 4, 2000

Before ABRAMS, FRANKFORT and NASE, **Administrative Patent Judges**.

ABRAMS, **Administrative Patent Judge**.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1-7, 19 and 20. Claims 8-18 have been withdrawn from consideration as being directed to non-elected species.

The appellant's invention is directed to a wobble-

absorbing magnetic bearing for a drive system. The claims on appeal have been reproduced in an appendix to the Brief.

THE REFERENCE

The reference relied upon by the examiner to support the final rejection is:

Bardocz 3,720,849 Mar. 13, 1973

THE REJECTIONS

Claims 1-7, 19 and 20 stand rejected under 35 U.S.C. § 112, first and second paragraphs, on the basis that the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

Claims 1-7, 19 and 20 also stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bardocz.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and the appellant regarding the rejections, we make reference to the Examiner's Answer (Paper No. 29) and the final rejection (Paper No. 18), and to the Appellant's Briefs (Papers No. 28

and 31).

OPINION[1]

The Rejections Under 35 U.S.C. § 112

Considering first the rejection under the first paragraph of section 112, the examiner has not specified, nor can we determine from the expression of the rejection, whether the shortcoming in the appellant's disclosure is under the description requirement or the enablement requirement. In any event, we point out that in order to meet the written description requirement, the appellant does not have to utilize any particular form of disclosure to describe the subject matter claimed, but "the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed."
In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Put another way, "the applicant must . . . convey with reasonable clarity to those skilled in the art that, as

[1]The propriety of the examiner's refusal to include claims 12, 17 and 18 under the elected species, from which relief is requested on page 24 of the Brief, is a petitionable matter, not an appealable one. See Manual of Patent Examining Procedure (MPEP) §§ 1002 and 1201.

of the filing date sought, he or she was in possession of the invention." ***Vas-Cath, Inc v. Muhurkar***, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). In our view, the description of the invention provided in the application is sufficient to convey to one of ordinary skill in the art that the appellant was in possession of the claimed invention at the time the application was filed.

The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation. See ***United States v. Telectronics, Inc.***, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), cert. denied, 490 U.S. 1046 (1989). It is our opinion that the disclosure of the invention provided in the specification meets this test.

We therefore will not sustain the rejection under 35 U.S.C. § 112, first paragraph.

Turning to the rejection under the second paragraph of Section 112, while not explicitly stated, it would appear that the examiner believes the claims are indefinite because the

terms “driving bearing element,” “driven bearing element,” “means for receiving,” and “means for applying driving,” which are present in claim 1, and “means for applying,” which appears in claims 1 and 19, do not provide “clear elucidation” of the claimed subject matter (see final rejection, page 3). The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. ***See***, for example, ***In re Johnson***, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. ***Id***.

It is clear to us from the explanation provided on pages 1 through 23 of the specification, with particular reference to Figures 1-5 and from reading in their entirety the portions of the claims in which the phrases quoted above appear, that one of ordinary skill in the art would understand the terms

mentioned by the examiner. That is, relating the terms to the chosen species of Figure 5, the driving bearing element is the lower element, as shown, to which the numeral 112 is applied, the driven bearing element is the upper element, as shown, to which the numeral 113' is applied, the means for receiving driving contact is the bottom portion of the lower element or elements attached thereto (such as bar 210 of Figures 1-3), the means for applying driving contact from the driven bearing element is the upper portion of the upper element (such as the threaded opening of Figure 5), and the means for applying magnetic force is the magnet 17.

The examiner's position appears to be that all of the elements recited in the claims before us must be shown in Figure 5, which is the chosen embodiment. We know of no requirement that such be the case. The fact of the matter is that the entirety of the structure is shown in Figures 1-3, with details of the various magnetic bearings being shown in the other figures. From our perspective, the claims are not indefinite, and one of ordinary skill in the art would have no trouble determining the metes and bounds of the claimed subject matter.

We will not sustain the rejection under 35 U.S.C. § 112, second paragraph.

The Rejection Under 35 U.S.C. § 102(b)

It is the examiner's position that "to the limited extent understood," claims 1-7, 19 and 20 are anticipated by Bardocz (final rejection, page 3). It is axiomatic that anticipation under 35 U.S.C. § 102(b) is established only when a single prior

art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See, for example, ***In re Paulsen***, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994) and ***In re Spada***, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). That is not the case here, and we will not sustain this rejection. Our reasoning follows.

The appellant's invention is directed to a "wobble-absorbing magnetic bearing for a drive system," the objective of which is to accommodate inaccuracies that may be present in a driving mover as it moves a driven object. As manifested in claim 1, the invention comprises a driving bearing element having a first surface and a driven bearing element having a second surface "that faces the first surface along a drive direction," and rolling elements disposed between the surfaces to "enable the driving and driven bearing elements to move substantially freely, relative to each other, along at least one direction transverse to the drive direction" and to

"transmit drive forces along the drive direction from the driving bearing element to the driven bearing element." Relating this to Figure 5, the drive direction is essentially perpendicular to the planes of the facing surfaces

of elements 112 and 14', and therefore the direction transverse to the drive direction is parallel to the planes of the aforementioned facing surfaces.

Bardocz is directed to a system which allows precision alignment of a linearly translatable element (Z) with respect to a platform element (R). Bardocz discloses a lower element (V) and an upper element (Z). Each element has a surface that faces the other, and interposed between the two elements are a plurality of balls mounted in grooves in the opposed surfaces. The elements are held together by magnetic force. By means of inputs applied by a coarse adjustment drive (T) and a fine adjustment drive (M), the upper element is positionable transversely with respect to the lower element. Considering that the “drive direction” in the appellant’s claim 1 is perpendicular to the facing surfaces, the Bardocz mechanism causes the elements to move relative to one another along a “direction transverse to the drive direction,” in the language of claim 1.

However, Bardocz fails to disclose some of the other features of claim 1. Looking to the specific language of claim 1, Bardocz is not disclosed as a “bearing,” much less a

bearing for applying force from a driving mover to move a driven object along a drive direction, that is, a direction perpendicular to the planes of the facing surfaces of the two elements. Nor is one of the elements "freely" movable with respect to the other, as evidenced by the presence of the two adjustment screw means that engage (as T) or are attached (as M) to the elements, thus fixing them together. In addition, there is no disclosure in Bardocz of moving the two elements in the "drive direction," nor is there reason to conclude that such movement is inherent. Thus, as might be expected, Bardocz fails to disclose a driving mover and a driven object which interact with the two elements, or the "means for receiving driving contact from the driving mover at the driving bearing element" and "means for applying driving contact from the driven bearing element to the driven object."

This being the case, Bardocz does not anticipate the subject matter of claim 1, and we will not sustain this rejection of claim 1 or of claims 2-7, which depend therefrom.

Independent claim 19 also is directed to a wobble-

absorbing magnetic bearing that applies force from a driving mover to move a driven object. As recited in this claim, the invention specifies that the rolling elements be of nonmagnetic material.

This feature clearly is not taught by Bardocz, and therefore the reference cannot be anticipatory of the subject matter recited in claim 19.

The Section 102(b) rejection of claim 19 and dependent claim 20 therefore is not sustained.

SUMMARY

The rejection of claims 1-7, 19 and 20 under 35 U.S.C. § 112, first and second paragraphs, is not sustained.

The rejection of claims 1-7, 19 and 20 under 35 U.S.C. § 102(b) is not sustained.

The decision of the examiner is reversed.

REVERSED

NEAL E. ABRAMS Administrative Patent Judge	)	
CHARLES E. FRANKFORT Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)	

NEA:hh

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